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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,733	11/21/2001	Gregory D. Johnson	13190.101	9460

24283 7590 07/13/2006

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EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/993,733	Applicant(s) JOHNSON, GREGORY D.	
	Examiner Walter B. Aughenbaugh	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 28 June 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

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ADVISORY ACTION

1. Applicant's Request for Reconsideration filed June 28, 2006 has been received and considered by Examiner.
2. No amendments were made in the claims in Applicant's June 28, 2006 submission.
3. Applicant's arguments regarding the 35 U.S.C. 112, first paragraph rejection made of record in paragraph 7 of the previous Office Action mailed April 4, 2006 have been fully considered but are not persuasive.

Applicant's statement that "the 70% higher end of all the ranges and the 40% was in the original specification" is unsupported, and Applicant has not explained how this statement addresses the 35 U.S.C. 112, first paragraph rejection of record.

Applicant's statement "... is simply a repeat of the previous rejection" is unsupported. It is unclear what rejection Applicant refers to by "the previous rejection". If a basis for rejection is raised for the first time, the rejection that relies on that basis is necessarily a new rejection. It is unclear what basis Applicant has for regarding the 35 U.S.C. 112, first paragraph rejection made of record in paragraph 7 of the previous Office Action mailed April 4, 2006 as a rejection that is "simply a repeat of the previous rejection", i.e. not a new rejection.

Applicant has misrepresented that which is stated in paragraph 11 of the previous Office Action mailed April 4, 2006. Applicant states that the Office Action states that *Wertheim* and MPEP [in regard to *Wertheim*] state that the range of 35-60% at issue in *Wertheim* does not meet the description requirement given the facts of *Wertheim*: the Office Action does not state this. The Office Action indicates that *Wertheim* is only applicable when the specification includes an example that supports the endpoint, and therefore, *Wertheim* is not applicable in the instant

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application. Paragraph 11 of the previous Office Action mailed April 4, 2006. The *Wertheim* court found that an example of 36% supports the endpoint of 35%. As stated in paragraph 11 of the previous Office Action mailed April 4, 2006, "Applicant's specification as originally filed does not disclose any example values". Applicant's response to paragraph 11 of the previous Office Action mailed April 4, 2006 does not address the distinction between *Wertheim* and the instant application raised in the Office Action. Applicant has not addressed the Office's position that *Wertheim* is not applicable in the instant application.

Applicant has not explained how Applicant's statement that "the 32% limit is within the range taught by the present application" addresses the 35 U.S.C. 112, first paragraph rejection of record. The range that is disclosed in the specification as originally filed is 10-70%. It is unclear whether or not Applicant's statement that "this type of amendment has always been viewed..." is applicable to the instant application since it is unclear what Applicant refers to by "this type of amendment" and whether or not the amendment at issue in the *Reeves Bros., Inc.* case would be considered the same "type of amendment" as the amendment at issue in the instant application.

4. Applicant's arguments regarding the 35 U.S.C. 103 rejections have been fully considered but are not persuasive. Applicant argues that Sobolev "does not say that this range can be reached with foam, but Sobolev's teaching at col. 12, lines 3-10 requires that the ranges taught at col. 12, lines 3-10 can be reached with foam. Sobolev does not "show[]" that the ranges taught at col. 12, lines 3-10 are "not attainable with foam" as Applicant argues. Applicant's arguments that "those skilled in the art would not to look Sobolev for what was desirable" and that Sobolev teaches that "microballoons are desired" contradicts Applicant's unsupported statement that those skilled in the art "would elect to use microballoons, not foam". If "those skilled in the art

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would not to look Sobolev for what was desirable”, those skilled in the art would not have a reason to elect to use microballoons over a foaming agent. Sobolev does not teach that the ranges taught at col. 12, lines 3-10 are “not attainable with foam” as Applicant argues.

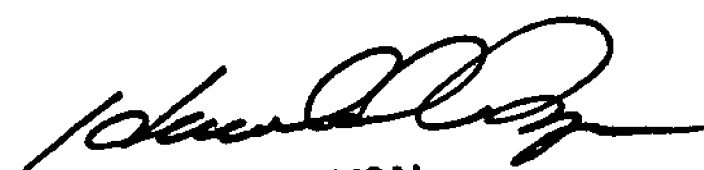
Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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07/10/06 WBA


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SUPERVISORY PATENT EXAMINER
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7/10/06